

### Remarks

Claims 108-116, 137 and 138 are pending in this Application. Claims 102-107 and 117-136 have been withdrawn. Applicants reserve the right to request rejoinder of one or more of the withdrawn claims during prosecution.

In an Office Action mailed November 25, 2008, the Examiner:

- objected to the drawings under 37 C.F.R. 1.83(a);
- rejected Claims 112 and 137 under 35 U.S.C. 112, first and/or second paragraph;
- rejected Claims 108-113 and 137 under 35 U.S.C. 102(b); and
- rejected Claims 114-116 and 138 under 35 U.S.C. 103(a).

On page 2 of the Office Action the drawings were objected to and said to now show a lathe assembly adapted to move the elongate body longitudinally in relation to the support rollers and the profiling tool. Applicants respectfully submit that a lathe assembly is adequately disclosed in the drawings showing elements such as column 5, base 1, rails 2,3, chucks 4, lateral supports 6, 7, drive means 8, profiling assembly 9. Furthermore, the drawings show chucks 4 being longitudinally moveable with respect to base 1. The specification teaches that the relationship allows chucks to be moved along rails 2,3 into engagement with opposite longitudinal ends of column 5 to be profiled (e.g., pg. 10, ll. 16-21 and pg. 12, ll. 15-18 of the originally filed specification, WO 2005/032784). Relative movement of column 5 in relation to the support rollers and the profiling tool is stated in the specification, for example, by longitudinally moving chucks 4, thus moving column 5 with respect to base 1. One skilled in the art understands such a description in view of the drawings and would agree that the drawings show chucks moveable along rails, regardless of action, which may include engagement with ends of an elongate body or to move an elongate body longitudinally in relation to the support rollers and the profiling tool. As such, each feature of the invention as claimed is shown and Applicants respectfully submit that no corrections or further drawings are in order.

On pages 3 and 4 of the Office Action, Claim 112 is rejected under 35 U.S.C. 112, first and second paragraph. The Examiner states that the claimed subject matter of Claim 112 is not supported by the specification and is indefinite. Applicants respectfully disagree and point out that an interpretation made by the Examiner on page 4 that “the elongate body rotates but does not move longitudinally” is incorrect. Applicants describe in the original application as filed that with a lathe assembly as described and claimed, lathe steadies 6 and 7 and profiling assembly 9 are held stationary and column 5 is moved longitudinally with respect to the base by traversing chucks 4 along rails 2 and 3 (e.g., see pg. 12, ll. 15-23 of the originally filed specification, WO 2005/032784). As such, Applicants respectfully submit that Claim 112 is both supported by the specification and distinctly claims subject matter described in the specification.

On pages 4 and 5 of the Office Action, Claim 137 is rejected under 35 U.S.C. 112, second paragraph for being indefinite. Applicants respectfully point out that Claim 137 does not further limit Claim 108 because subject matter of Claim 137 is directed to an elongate tubular body. For convenience, Applicants have amended Claim 137 to make this clear.

On pages 5 and 6 of the Office Action Claims 108-113 and 137 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,475,539 (hereinafter “Beauchemin”). Applicants respectfully traverse the rejection, pointing out that Beauchemin does not teach each and every element of Applicants’ claimed invention. For example, Beauchemin does not teach or suggest pair of chucks to engage opposite ends of a tubular body nor does Beauchemin teach, show or suggest lateral supports to support the tubular body at two or more support locations between its ends. In fact, Beauchemin specifically discloses and shows that only one end of a workpiece 17 is engaged with collet 15 (e.g., Col. 1, ll. 47-55). Moreover, Beauchemin explicitly describes that its rollers 36 are located to guide and support a *free end* of the workpiece (e.g., Col. 2, ll. 14-19). Thus, collet 15 engages only one end of workpiece 17 while the other end is unsupported and free.

Applicants further submit that upon further review of Beauchemin, it appears that the device is not operable to machine along a length of a workpiece. For example, Fig. 1 of

Beauchemin shows forming device 19 mounted into tail stock 9. This assembly requires that a cutting head of device 19 is *only* able to extend up the shank of workpiece 17 as far as the depth of the forming device will allow entry of the workpiece shank. Forming device 19 is closed at its end mounted into tail stock 9. Moreover, Applicants find that there is no means of moving the forming device of Beauchemin along the long axis of workpiece 17. None is described and, thus, none exists. Accordingly, the forming device of Beauchemin is only capable of profiling the *ends* of a workpiece. It is further noted that there is no feature in Beauchemin that will facilitate longitudinal travel of a cutting head. Thus, Beauchemin also does not disclose rotating the body about a longitudinal axis or a drive means for rotating the body about a longitudinal axis. As an additional point, the device of Beauchemin does not teach, show or suggest support rollers connected to a base. As a result, one skilled in the art knows that the device Beauchemin will exert significant "chatter" of the cutting tool against the workpiece, particularly when machining a workpiece that may be long (relative to its diameter) and/or one that may be hollow and/or one that has a very thin wall. Instead, the device of Beauchemin explicitly teaches that one end of workpiece 17 is engaged by collet 15 at head stock 7 (at 19) (Col. 1, line 47 to Col. 2, line 5). The other end of workpiece 17 is guided by rollers 36. Such an arrangement, as would be understood by those skilled in the art, is not suitable for supporting any thin walled hollow workpiece. The figures of Beauchemin show rollers 36 are spring mounted, which would also make them unable to dampen any chatter of the workpiece. Clearly, the Beauchemin device is not intended for anything but profiling the ends of a workpiece and the Beauchemin device will not work when workpieces are hollow or thin walled (which are unable to be profiled with only one end clamped in a head stock, as is clearly and explicitly shown and described by Beauchemin). As such, Applicants submit that Beauchemin does not anticipate Applicants' claimed invention because it does not teach each and every element of Applicants' claims.

Applicants' further submit that Beauchemin cannot be used for a showing of obviousness for the reasons provided above. The Beauchemin device does not teach each and every element nor Applicants' claimed invention on its whole. One skilled in the art would have to entirely re-design and reconstruct a device, such as that provided by Beauchemin, and the reconstruction is not made obvious by Beauchemin because there is no suggestion by Beauchemin to make

anything other than the Beauchemin device. Applicants have also previously discussed that the Beauchemin device would not work on hollow or thin walled workpieces. As such, Applicants respectfully submit that Claims 108-113 and 137 are patentable and are not anticipated by Beauchemin and Claims 114-116 and 138 are not made obvious by Beauchemin.

Applicants respectfully request the objections to the drawings and rejections to the claims be removed.

### **Conclusion**

Applicants respectfully submits that the Application is in condition for allowance and earnestly seeks allowance of the claims provided in the Listing of Claims beginning on page 2 of this paper.

Should the Examiner have questions, comments, or suggestions in furtherance of prosecution of this Application, please contact Applicants' representative at 214.999.4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review the Application or this Amendment if the Examiner believes that such an interview would assist in advancement of this Application.

Fees due with this response in cooperation with a Petition of Extension of Time is submitted with this response. Should additional fees be due, the Commissioner is hereby authorized to charge payment of said fees to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 131279-1052.

In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicant respectfully requests that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

This is intended to be a complete response to an Office Action mailed November 25, 2008. This Amendment has been submitted electronically.

**Please direct all correspondence to the practitioner listed below at Customer No. 60148.**

Respectfully submitted,

GARDERE WYNNE SEWELL LLP

A handwritten signature in black ink, reading "Monique A. Vander Molen". The signature is fluid and cursive, with the first name "Monique" and last name "Molen" being more prominent than the middle initial "A".

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